

ATTORNEY DOCKET NO. US 010499
U.S. SERIAL NO. 09/971,143
PATENT

REMARKS

Claims 1-20 are pending in this application.

Claims 1-20 have been rejected.

Claims 1, 11 and 18 have been amended.

Claims 1-20 remain pending in this application.

Reconsideration of Claims 1-20, as amended, is respectfully requested.

I. REJECTIONS UNDER 35 U.S.C. § 102

The September 8, 2004 Office Action rejected Claims 1-10, Claims 13-15 and Claims 19-20 under 35 U.S.C. § 102(e) as being anticipated by United States Patent Application Publication No. 2001/0018660 A1 to Sehr ("Sehr"). This rejection is respectfully traversed.

A prior art reference anticipates the claimed invention under 35 U.S.C. §102 only if every element of a claimed invention is identically shown in that single reference, arranged as they are in the claims. MPEP §2131; *In re Bond*, 910 F.2d 831, 832, 15 U.S.P.Q.2d 1566, 1567 (Fed. Cir. 1990). Anticipation is only shown where each and every limitation of the claimed invention is found in a single prior art reference. MPEP §2131; *In re Donohue*, 766 F.2d 531, 534, 226 U.S.P.Q. 619, 621 (Fed. Cir. 1985).

Amended independent Claim 1 and previously amended independent Claim 13 each recite a method and system in which an application program is downloaded into a virtual ticket device for use in connection with an electronic ticket control system. The *Sehr* reference describes a visitor

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card onto which may be loaded information and data such as seat assignments [0048], monetary values and electronic payment forms [0049], electronic tickets [0051], entrance and exit stamps [0052]. The visitor cards may be so-called "smart" cards, "handheld terminals or any pocket sized computer configurations" [0035]. However, *Sehr* does not teach downloading programs onto the visitor cards. Therefore, the *Sehr* reference does not anticipate downloading an application program into a virtual ticket device for use in connection with an electronic ticket control system, as recited in amended independent Claim 1 and in the previously amended independent Claim 13.

The Examiner stated in the September 8, 2004 Office Action, "Applicant argues that *Sehr* does not anticipate 'downloading an application program into a virtual ticket device for use in connection with an electronic ticket control system.' Contrary to applicant's arguments, *Sehr* does teach downloading data and information to be stored in the card, and to accumulate appropriate bonus points to be used for future services and consumptions as claimed (page 15, [0113])." (September 8, 2004 Office Action, Page 8, Line 20 to Page 9, Line 3). The Applicants respectfully traverse this assertion of the Examiner for the following reasons.

The Applicants did not argue that *Sehr* does not teach "downloading data and information." In the Applicants' Amendment of June 7, 2004 the Applicants stated that *Sehr* teaches downloading "information and data such as seat assignments [0048], monetary values and electronic payment forms [0049], electronic tickets [0051], entrance and exit stamps [0052]." (June 7, 2004 Amendment and Response to Office Action, Page 11, Lines 7-8). The Applicants are asserting that *Sehr* does not

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teach downloading "an application program" in a virtual ticket device. Data and information standing alone do not comprise "an application program."

In rejecting Claim 11 and Claim 16 under 35 U.S.C. § 103(a) the Examiner stated "However, Sehr does not specifically disclose that the electronic ticket control system includes a downloadable user-interface program." (September 8, 2004 Office Action, Page 6, Lines 23-24). The *Sehr* reference does not disclose the concept of downloading a user-interface program. The *Sehr* reference also does not disclose the concept of downloading "an application program" into a virtual ticket device.

In order to clarify the language of the Applicants' claims, the Applicants have amended Claim 1, Claim 11 and Claim 18 to change the words "an application" to the words "an application program." This does not change the meaning of the term "application" as that term is generally known and used in the computer industry. It is well known that the term "application" refers to and means a computer program. The amendments of Claim 1, Claim 11 and Claim 18 are being made for clarification purposes only and do not change the scope of the claimed subject matter.

For the reasons set forth above, the *Sehr* reference fails to anticipate each and every limitation of the Applicants' invention arranged as they are set forth in amended independent Claim 1 (and Claims 2-10 and Claims 19-20 that depend from amended Claim 1) and as they are set forth in previously amended independent Claim 13 (and Claims 14-15 that depend from previously amended Claim 13). Accordingly, the Applicants respectfully request the Examiner to withdraw the § 102 rejections and pass to allowance Claims 1-10 and Claims 13-15 and Claims 19-20.

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II. REJECTIONS UNDER 35 U.S.C. § 103

The September 8, 2004 Office Action rejected Claims 11- 12 and Claims 16-18 under 35 U.S.C. § 103(a) as being unpatentable over *Sehr*. This rejection is respectfully traversed.

In *ex parte* examination of patent applications, the Patent Office bears the burden of establishing a *prima facie* case of obviousness. MPEP § 2142; *In re Fritch*, 972 F.2d 1260, 1262, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992). The initial burden of establishing a *prima facie* basis to deny patentability to a claimed invention is always upon the Patent Office. MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 U.S.P.Q. 785, 788 (Fed. Cir. 1984). Only when a *prima facie* case of obviousness is established does the burden shift to the applicant to produce evidence of nonobviousness. MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). If the Patent Office does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of a patent. *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Grabiak*, 769 F.2d 729, 733, 226 U.S.P.Q. 870, 873 (Fed. Cir. 1985).

A *prima facie* case of obviousness is established when the teachings of the prior art itself suggest the claimed subject matter to a person of ordinary skill in the art. *In re Bell*, 991 F.2d 781, 783, 26 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1993). To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the

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references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed invention and the reasonable expectation of success must both be found in the prior art, and not based on the applicant's disclosure. MPEP § 2142.

With respect to Claim 11 and Claim 16, the Examiner stated that "However, Sehr does not specifically disclose that the electronic ticket control system includes a downloadable user-interface program." (September 8, 2004 Office Action, Page 6, Lines 23-24). The *Sehr* reference does not disclose the concept of downloading a user-interface program. As previously mentioned, the *Sehr* reference also does not generally disclose the concept of downloading an application program into a virtual ticket device.

The Examiner stated that "Thus, it would have been obvious to one of ordinary skill in the art at the time of the invention to have had the electronic ticket control system of Sehr include a downloadable user-interface program in order to ensure that the handheld terminals or any pocket-sized computer configurations would function with the system and method." (September 8, 2004 Office Action, Page 6, Line 24 to Page 7, Line 3). The Applicants respectfully traverse this assertion of the Examiner. The Applicants respectfully submit that there is no teaching or suggestion in the prior art or motivation to combine a downloadable user-interface program with the *Sehr* system.

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In order to establish obviousness by combining references or modifying references there must be some teaching or suggestion in the prior art to combine or modify the references. *Arkie Lures, Inc. v. Gene Larew Tackle, Inc.*, 119 F.3d 953, 957, 43 USPQ2d 1294, 1297 (Fed.Cir. 1997) ("It is insufficient to establish obviousness that the separate elements of an invention existed in the prior art, absent some teaching or suggestion, in the prior art, to combine the references."); *In re Rouffet*, 149 F.3d 1350, 1355-56, 47 USPQ2d 1453, 1456 (Fed.Cir. 1998) ("When a rejection depends on a combination of prior art references, there must be some teaching, or motivation to combine the references.")

Evidence of a motivation to combine prior art references must be clear and particular if the trap of "hindsight" is to be avoided. *In re Dembiczak*, 175 F.3d 994, 50 USPQ2d 1614 (Fed.Cir. 1999) (Evidence of a suggestion, teaching or motivation to combine prior art references must be "clear and particular." "Broad conclusory statements regarding the teaching of multiple references, standing alone, are not 'evidence.'"). *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457 (Fed.Cir. 1998) ("[R]ejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be 'an illogical and inappropriate process by which to determine patentability.'")

The Applicants respectfully submit that the alleged motivation to modify the *Sehr* reference presented by the Examiner does not meet the legal requirement to establish a finding of *prima facie* obviousness. The Applicant respectfully submits that the alleged motivation to modify the *Sehr*

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references is not clear and particular. The Examiner stated that the alleged motivation for having the electronic ticket control system of *Sehr* include a downloadable user-interface program was "in order to ensure that the handheld terminals or any pocket-sized computer configurations would function with the system and method." (September 8, 2004 Office Action, Page 7, Lines 1-3).

The Applicants respectfully traverse this assertion of the Examiner. The alleged motivation is not "clear and particular." The phrase "system and method" is ambiguous. Does the phrase "system and method" refer to the *Sehr* system? Does the phrase "system and method" refer to an external "application program" that is to be added to the *Sehr* system? Either way, the *Sehr* reference is silent concerning the addition of a downloaded user-interface application program to the *Sehr* system. The inherent operation of the handheld terminals of the *Sehr* system does not without more provide a "clear and particular" motivation to modify the *Sehr* reference to add a downloadable user interface program to the *Sehr* system. The Applicants respectfully submit that the alleged motivation to modify the *Sehr* reference has been assumed by "hindsight" in light of the existence of the Applicants' invention.

The Applicants respectfully submit that Claim 11, as amended, and Claim 16, are patentable over the *Sehr* reference. The Applicants respectfully request that Claim 11, as amended, and Claim 16 be passed to allowance.

Claim 12 depends directly from amended independent Claim 1 and includes the limitations of amended independent Claim 1. Similarly, Claim 17 depends directly from previously amended Claim 13 and includes the limitations of previously amended independent Claim 13. Thus, for the

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reasons described above with regard to Claim 1 and Claim 13, the *Sehr* reference does not teach or suggest all the limitations of Claim 12 and Claim 17. Therefore, a *prima facie* case of obviousness has not been established. The Applicants respectfully submit that Claim 12 and Claim 17 are patentable over the *Sehr* reference. The Applicants respectfully request that Claim 12 and Claim 17 be passed to allowance.

With regard to Claim 18, amended independent Claim 18 recites the limitation of downloading into a virtual ticket device an application program for use in connection with an electronic ticket control system. Thus, for the reasons described above with regard to amended Claim 1, *Sehr* does not teach or suggest all the limitations of amended independent Claim 18. Therefore, a *prima facie* case of obviousness has not been established. The Applicants respectfully submit that Claim 18 is patentable over the *Sehr* reference. The Applicants respectfully request that Claim 18 be passed to allowance.

The Applicants respectfully request that the rejection of Claims 11-12 and Claims 16-18 under 35 U.S.C. § 103(a) be withdrawn and that Claims 11- 12 and Claims 16-18 be passed to allowance.

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III. CONCLUSION

For the reasons given above, the Applicants respectfully request reconsideration and full allowance of all pending claims and that this application be passed to allowance. The Applicants deny any statement, position or averment of the Examiner that is not specifically addressed by the foregoing argument and response. The Applicants reserve the right to submit further arguments in support of her above stated position as well as the right to introduce relevant secondary considerations including long-felt but unresolved needs in the industry, failed attempts by others to invent the invention, and the like, should that become necessary.

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SUMMARY

If any outstanding issues remain, or if the Examiner has any further suggestions for expediting allowance of this application, the Applicants respectfully invite the Examiner to contact the undersigned at the telephone number indicated below or at wmunck@davismunck.com.

The Commissioner is hereby authorized to charge any additional fees connected with this communication (including any extension of time fees) or credit any overpayment to Deposit Account No. 50-0208.

Respectfully submitted,

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Date: Oct. 20, 2004



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